89-1866

NO. _____

Supreme Court, U.S.
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IN THE

Supreme Court of The United States

October Term, 1989

FRANKLIN PIERCE LAW CENTER,
Petitioner

v.

GEORGETOWN UNIVERSITY,
Respondent

Petition For A Writ of Certiorari to the United States Court of Appeals For The Federal Circuit

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QUESTIONS PRESENTED FOR REVIEW

1. In the face of Congressional enactment of a statutory test of "distinctiveness" for protecting descriptive trademarks in the United States Patent and Trademark Office (Sec. 2f of Lanham Act), is the Court of Appeals for the Federal Circuit correct in holding, as in the present case, that in addition to such statutory distinctiveness, it is essential to prove also strict "secondary meaning" and that by means of a "scientifically accurate survey"; these holdings being *in direct and confusing conflict* with holdings of a growing number of other Federal Circuit Courts of Appeals that strict "secondary meaning" need no longer be shown and that even "secondary meaning" does not require a "scientifically accurate survey"?

2. Can such two totally opposing legal tests be tolerated for the protection of descriptive trademarks—one enunciated by the Court of Appeals for the Federal Circuit in deciding litigation between an opposer and a trademark applicant in the United States Patent and Trademark Office, and a *diametrically contrary rule* should the opposer and applicant meet on the same issue in at least the Courts of Appeals for the Second, Fifth and Seventh Circuits, in common law trademark infringement and unfair competition litigation?

3. Can the thousands of trademark applicants who now annually apply to the United States Patent and Trademark Office under Sec. 2f of the Lanham Act, any longer rely on Congressional statutory guidelines to establish "distinctiveness" by "substantially exclusive and continuous use" in commerce for five years—a test now also adopted verbatim by a growing number of states in their intrastate trademark laws?

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In The
Supreme Court of the United States

October Term, 1989

No.

FRANKLIN PIERCE LAW CENTER,
Petitioner,

v.

GEORGETOWN UNIVERSITY,
Respondent.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Franklin Pierce Law Center, respectfully prays that a Writ of Certiorari issue to review the judgement of the United States Court of Appeals for the Federal Circuit in this case.

RULE 29 STATEMENT

Petitioner Franklin Pierce Law Center is a New Hampshire non-profit corporation with no parent or subsidiary companies.

OPINIONS BELOW

The opinion of the Court of Appeals for the Federal Circuit (CAFC) affirming the decision of the Trademark Trial and Appeal Board (TTAB) of the United States Department of Commerce Patent and Trademark Office (PTO), is unreported and appears as Appendix A to this petition (A. 1a-2a).

The decision of the Trademark Trial and Appeal Board, also unreported, appears in said Appendix A at A. 3a-11a.

JURISDICTION

The judgement of the Court of Appeals was entered on January 25, 1990 and a petition for rehearing and suggestion for rehearing in banc was denied on February 23, 1990 (A. 12a). The jurisdiction of this Court is invoked pursuant to 28 U.S.C. §1254(1). This petition is filed within 90 days of the date of denial of the petition for rehearing.

STATUTES INVOLVED

15 U.S.C. §1052(f), Lanham Act § 2(f)
15 U.S.C. § 1063

STATEMENT OF THE CASE

Franklin Pierce Law Center (FPLC), New Hampshire's only law school and the home of the Patent Trademark and Copyright (PTC) Research Foundation, adopted the name The Journal of Law and Technology as a trademark in 1976 for concurrent use with the mark IDEA for its journal (A. 4a).

The record in this case and the undisputed facts found by the Patent and Trademark Office Trademark Trial and Appeal Board (TTAB) and concurred in by the Court of Appeals for the Federal Circuit (CAFC) show that at the time of adoption of the mark, The Journal of Law and Technology, the Law Center was the first and only entity using that mark. The mark was applied to the Law Center's journal containing articles and commentary on "science, innovation and legal systems"

(A. 5a)—the areas of speciality and the thrust underlying the very founding of the Law Center by its current president, Boston patent attorney Robert H. Rines.

For *ten years* the Law Center was the *exclusive and continuous user* of this trademark for a journal (A. 3a, 4a) until students at Georgetown University in the spring of 1986 decided, *as a new-comer,* to adopt the identical mark for a journal of their own (A. 5a), prompting the Law Center to file an application for federal registration of its common law trademark (A. 3a) with the United States Patent and Trademark Office.[1]

Recognizing the Law Center's long and exclusive prior use of this mark, the PTO examining Trademark Attorney ruled, in connection with the Law Center's application for registration,

> In view of your long use of the mark, your attention is directed to Section 2(f) of the Trademark Act (15 U.S.C. 1052(f)). A proper claim of distinctiveness should state that you believe the mark has become distinctive as applied to the goods (or services) as a result of your substantially exclusive and continuous use in commerce (specifying the type of commerce) for the five years next preceding the filing date of this application. Such a claim must be supported by an affidavit or by a declaration (37 CFR Sections 2.20 and 2.41) signed by the applicant.

Whereupon the Law Center complied with the Trademark Attorney's requirement and filed such an affidavit, fully complying with the statutory test or guidelines thus established by Congress in Sec. 2f of the so-called Lanham Act. The PTO Trademark Attorney thereupon allowed the application and passed it on for publication so that other members of the public concerned with likelihood of confusion to the public and possible damage to such members could file a notice of opposition thereto in the PTO (15 U.S.C. §1063)—i.e. a complaint, governed by the Federal Rules of Civil Procedure.

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[1] This apparently encouraged similar action by students at Harvard, though the TTAB found that "as of January 1988 the first issue had yet to be published." (A. 5a).

Georgetown accordingly filed such a notice of opposition *(Georgetown University v. Franklin Pierce Law Center Incorporated,* Opposition 76,021) to litigate these issues. The thrust of Georgetown's complaint was that "The Journal of Law and Technology" was a *generic* name (not just descriptive) and as such could never be appropriated by anyone as a trademark—it was free for everybody to use.

Georgetown's Proofs

At the opposition trial, Georgetown produced as witnesses a former student from its law school and a student from Harvard who testified to views as to the alleged generic, not just descriptive, character of the mark.

At no time did Georgetown ever deny that the Law Center had been the first to adopt the mark in 1976, or that the Law Center had *exclusively* and *continuously used the same in commerce for ten years* right up until Georgetown decided to adopt the mark for its 1986 publication. There is no question but that the Law Center had fully met the statutory "distinctiveness" test of Sec. 2f (assuming the mark was merely descriptive and not generic). And the TTAB so found compliance with Sec. 2f (A. 3a).

Summary of Petitioner's Evidence on "Distinctiveness" or "Secondary Meaning"

For its proofs, as summarized by the TTAB and the Court of Appeals, the Law Center produced the testimony of its founder and president, Robert H. Rines—totally unrebutted[2]—confirming the facts set forth in its Sec. 2f affidavit, *supra,* of the creation and adoption of the mark by the Law Center in 1976 and of the exclusive and continuous and *world-wide* use of the mark in connection with its journal for more than a decade.

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[2] The record does not contain even a scintilla of evidence, nor did the TTAB or Court of Appeals state that it did, to rebut even the *prima facie* case for first adoption in 1976 by the Law Center and for its exclusive and continuous use thereafter up until the opposer appropriated the mark "In the spring of 1986" (TTAB-A. 5a), ten years later.

The Law Center did not, however, rest on its statutory Sec. 2f distinctiveness showing, but offered further evidence—none of which was in any way discredited by Georgetown—for demonstrating the establishment of distinctiveness and the accompanying developed goodwill in the mark with customers.

As to this there is also no dispute. In the words of the TTAB and Court of Appeals, the Law Center proved the following:

1. "The applicant's evidence on this ("secondary meaning") was that the words had been used as a subtitle for IDEA since 1976 . . ." (CAFC, A. 2a).
   ". . . use of the words as either part of the title or as the subtitle on covers of applicant's journal since 1976" (TTAB, A. 7a)

   (The Law Center produced sample copies of its quarterly journals from 1976 to date with every issue carrying the mark prominently on the cover and on the upper left hand pages[3a]).

2. "much money had been spent on the journal since that date" (1976) (CAFC, A. 2a).
   "expenditure of $600,000 by applicant on the journal since 1976" (TTAB, A. 7a).

   (The Law Center circulated its journal throughout the world, as it did advertising brochures, bulletins and at its annual PTC conferences.[3b])

3. "correspondence and invoices used the word sought to be registered" (CAFC, A. 2a)
   "references by applicant and others to applicant's journal using only the words sought to be registered . . . applicant . . . use them on invoices . . . subscribers . . . use them in correspondence regarding the journal . . . (TTAB, A. 8a.).

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[3]. References to Joint Appendix (App.) in proceedings below:
a. App. 77.
b. App. 68-75, 95-97, 107-181.

(The Law Center produced 1336 invoices representing subscriptions; 40 letters dating from 1977-1979; 108 inquiries from foreign institutions; 17 documents from U.S. government agencies; 43 documents from law firms; 54 letters and forms from universities and libraries—*all using the mark and all referencing the Law Center and/or its PTC as the source of the journal.*[3c])

4. "statements from 10 people attest to the fact that they are unaware of other journals using the name . . ." (CAFC A. 2a).
"ten selected subscribers to the journal . . . unaware of anyone else using (the mark) . . ." (TTAB, A. 8a, 9a).

(The Law Center also provided these statements from select customers, such as the editor of Europe's leading intellectual property journal with *expertise* on such publications.[3d])

Decision of TTAB

The primary thrust of the decision of the TTAB supported Georgetown's claim that the mark was *generic* (not just descriptive) and thus incapable of being a trademark:

> *"No amount or quality of evidence of distinctiveness* can lead to registration of the common name of a thing . . . As such, they are unregistrable under Section 2(e) (1) of the Act." (A. 7a, 9a). (Emphasis added).

As a catch-all, the TTAB stated that if its

> "holding that the terms sought to be registered is a generic name for applicant's goods were to be reversed on appeal . . . (and) even if these words could somehow be determined to be only merely descriptive of the goods, rather than a generic

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c. Exhibits 3-10, App. 123-167.
d. App. 98-107.

> name for them, applicant has failed to prove that they have acquired distinctiveness . . . (A. 7a, 10a)

Specifically, even though complying with Sec. 2f of the Lanham Act, applicant did not provide a *"scientifically accurate survey"* (emphasis added) to "persuade us that distinctiveness has been attained by these words" (A. 9a).

Decision of the Court of Appeals

Tacitly rejecting the holding of the TTAB that the mark is inherently unregistrable as *generic,* as distinguished from descriptive, and after summarizing the Law Center evidence of distinctiveness or secondary meaning, including un-rebutted compliance with the statutory test of Sec. 2f of the Lanham Act, *supra,* the Court of Appeals affirmed the decision of the TTAB denying registration upon the conclusory ground that the Law Center did not provide "a scientifically accurate survey". (A. 2a).

It will now be shown that these requirements imposed by the Court of Appeals for the Federal circuit are *in direct, confusing and hopeless conflict* with a fast-growing body of law in other Circuit Courts of Appeals (in particular the Second, Fifth and Seventh Circuits) as to the legal requirements for proving distinctiveness. Such, indeed, unlike the requirements of the CAFC, are consistent with the philosophy underlying Sec. 2f of the Lanham Act—which very Sec. 2f has now been adopted *verbatim* by a growing number of States in their intrastate trademark laws.[4]

REASONS FOR GRANTING THE WRIT

It is submitted that this Court should review the decision below because it conflicts with decisions of other federal courts of appeals on issues of fundamental importance in trademark

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[4] FLA. STAT. ANN. Sec. 495.021(e) (West 1987)
TEX. BUS. & COM. CODE ANN. Sec. 16.02(b) (Vernon 1987)
CAL. BUS & PROF. CODE Sec. 14220(e) (West 1987)
N.Y. GEN. BUS. LAW, Sec. 361(e) (McKinney 1984)
ILL. ANN. STAT. CH. 140, para. 9(2[e]) (Smith-Hurd 1986)

and unfair competition law, giving rise to what is now *hopeless confusion* in the different circuits.

Altogether apart from the equities of this case, recognized trademark commentators and treatise authors are also urging prompt clarification of the very issue so clearly defined in the present case:

Is the law of the land to be in the trend of the Congressional statutory *distinctiveness* (Sec. 2f), which is also the present direction in the Courts of Appeals of at least the Second, Fifth and Seventh Circuits (and of the States in adopting Sec. 2f in their intrastate laws), or does it also demand the older strict court-created "secondary meaning" requirement applied by the CAFC in this case?

The CAFC (and TTAB), as earlier discussed, while conceding unchallenged compliance with the statutory "distinctiveness" showing of Sec. 2f, have held that strict "secondary meaning" must also be shown to afford protection to a descriptive trademark.

The noted trademark commentator McCarthy[5], however, points out that

> "The 1946 Federal Lanham Act uses the term 'has become *distinctive*' . . . referring to the very same legal concept which is referred to herein as *'secondary meaning'* ". (p. 666, emphasis supplied)

He cites the above-mentioned current and growing conflicting legal requirements of the circuits, moreover, disclosing that, "even though traditional secondary meaning" is *not* proven, courts

> "led by the Federal Second Circuit in New York, have granted relief on grounds other than ('secondary meaning')." (McCarthy, *supra,* p. 669)

McCarthy entitles this the "New York Rule": "Substitutes for secondary meaning". He characterizes it as "A Break with Traditional Rules" and with the "traditional standard of

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[5] J. F. McCarthy, Trademarks and Unfair Competition, Second Edition, Vol. 1, 1984.

recovery for trademark infringement or unfair competition . . ." (McCarthy, *supra,* p. 669).

Circuit Conflicts on Requirement for Strict "Secondary Meaning"

Examples of such conflict are:

Second Circuit

> "Although secondary meaning usually is a prerequisite to trademark protection, New York law shields trade dress from deliberate copying even if it has not acquired a secondary meaning." *Harlequin Enterprises Ltd. v. Gulf & Western Corp.* 210 USPQ 1, 3; 644 F. 2d 946, 949 (2nd Cir. 1981).
>
> "But even if we assume that a secondary meaning was not established, the order still should be affirmed." *Lincoln Restaurant Corp. v. Wolfies Rest. Inc.,* 291 F. 2d 302, 303 (2nd Cir. 1961).
>
> ". . . to prove that an 'appreciable' quantum of consumers associated his name with his product in order to establish secondary meaning, was an erroneous interpretation of the law." *Yarmouth-Dion Inc. v. D'ion Furs Inc.,* 5 USPQ 2d, 1262, 1265 (2nd Cir. 1987).
>
> "Trademark infringement is a class within the general subject of unfair competition . . . The standard is the same under New York's law of unfair competition, except that under New York's law, a trademark *need not have acquired a 'secondary meaning'* or be associated in the minds of the public with its producer, in order to be unlawfully infringed." *Menley & James Laboratories, Ltd. v. Approved Pharmaceutical Corporation et al,* 195 USPQ 766, 769 (D.C. N.D. N.Y. 1977).
>
> ". . . unfair competition, notwithstanding the fact that plaintiff's mark had not yet acquired a sec-

ondary meaning . . .". *Flexitized, Inc. v. National Flexitized Corp.,* 335 F. 2d. 774, 781 (2nd Cir. 1964).

"Even where a secondary meaning has not been shown, courts will not remain passive if it appears that a producer has vested a descriptive term with a special commercial appeal . . ." *Bristol-Meyers Co. v. Approved Pharmaceutical Corp.,* 149 USPQ 896, 899 (N.Y.S.C. 1966).

Fifth Circuit

"Ortho was not required to show 'secondary meaning', as that term is understood in trademark law, to prevail under that section . . ." (Lanham Act, 15 U.S.C. 1125 (a)). *Chevron Chemical Co. v. Voluntary Purchasing Groups,* 659 F.2d 695, 696 (5th Cir. 1981).

"The district court also found that the Sicilia's bottle design had not acquired secondary meaning. Such a finding, however, is not a prerequisite for Sicilia to be entitled to protection." (citing *Chevron Chemical, supra). Sicilia Di R. Biebow & Co. v. Cox,* 732 F.2d 417, 426 (5th Cir. 1984).

Seventh Circuit

"However, secondary meaning is not necessary where the trade dress is distinctive." *Roulo v. Russ Berrie & Co.,* 12 USPQ 2d, 1423, 1427 (7th Cir. 1989).

"For 13 years Canfield was the only soft drink company using the label . . . The fact that only after . . . did companies . . . begin using the term . . . - is evidence of a secondary meaning." (Following the 2nd Circuit *Harlequin Enterprises*

case, *supra). A. J. Canfield Co. v. Vess Beverages, Inc.,* 230 USPQ 441, 443 (7th Cir. 1986).

Other Federal Courts

". . . the primary question in trademark infringement and unfair competition claims is whether or not the public is likely to be confused, rather than whether the senior user's trademark has acquired secondary meaning." *Marker International v. DeBruler,* 228 USPQ 906, 914 (D.C.D. Utah, 1986).

Even different panels of the TTAB disagree with the panel that decided the present case:

"the solemn declaration of appellant's substantially exclusive use for a period of five years has meaning not only from the stand point of recognition by purchasers of the product's source but also that competitors apparently recognize or have acquiesed in applicant's claim of trademark rights." *In re Synergistics Research Corp.,* 218 USPQ 165, 167 (TTAB, 1983).

Circuit Conflicts On Necessity for "Scientific Survey"

Not only is there conflict among the circuits (and within the circuits) as to whether strict "secondary meaning" need longer be proven to protect a descriptive mark under circumstances of long exclusive use analagous to Sec. 2f, but there is decided conflict with the further view of the CAFC in this case, that the Law Center had to provide a

"scientifically accurate survey"

to satisfy "secondary meaning" proof.

Directly contrary are the following decisions in other circuits:

2nd Circuit

"And though surveys have become the usual way of demonstrating secondary meaning . . . they are not the only way." *Centaur Communications Limited v. A/S/M Communications, Inc.,* 830 F. 2d. 1217, 1223 (2nd Cir. 1987).

1st Circuit

> ". . . to establish secondary meaning, survey evidence, though important . . . is not a requirement to a finding of secondary meaning." (Following the 2nd Circuit *Centaur Communications Limited* case, *supra) Kusan Inc. v. Fairway Siding Corp.*, 7 USPQ 2d 1202, 1206 (D.C.D. Mass. 1988).

7th Circuit

> "the existence of a survey is only one of the variety of factors . . . relevant to the issue of secondary meaning, and the plaintiff may resort to evidence other than a survey . . ." *International Kennel Club of Chicago v. Mighty Star Inc.*, 6 USPQ 2d 1977, 1982 (7th Cir. 1988).

And even a different panel of the CAFC disagrees with the current panel in your petitioner's case:

> ". . . absence of consumer surveys need not preclude a finding of acquired distinctiveness . . . To prove distinctiveness under 15 U.S.C. 1052(f), applicants may submit any appropriate evidence . . . *Yamaha International Corp. v. Hoshino Gakki Co. Ltd.*, 6 USPQ 2d 1001, 1010 (CAFC 1988).

So, also, do different panels of the TTAB disagree with this requirement imposed on petitioner by the TTAB panel and the CFAC in this case:

> "It is not, however, incumbent upon an applicant to conduct an exhaustive survey in order to establish a public recognition of his mark . . ." *In re The Procter & Gamble Co.*, 146 USPQ 672, 673 (TTAB 1965).

How pertinent is Derenberg's[6] comment:

> "much depends on the chance of the assignment calendar" !

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[6]. Derenberg, *Fourteenth Year of Trademark Act of 1946*, 52 Trademark Rep. 777, p. 823 (1961)

And, also, the commentary of Pattishall[7] decrying

> "the maze of contradiction and inconsistency which has so long characterized this field of law."

Other legal scholars have also been increasingly concerned with these two sets of laws for affording protection to widely used descriptive marks—one requiring proof of "secondary meaning" and the other *not* requiring strict "secondary meaning", but, rather, a showing more like the long exclusive use "distinctiveness" guideline established by Congress in Sec. 2f of the Lanham Act.

In a case comment several decades ago in the *Duke Law Journal*[8], the editors pleaded that

> "Serious consideration should be given to these implications before the "secondary meaning" requirement is either relaxed or discarded";

predicting the very confusion that now exists, and specifically noting

> "existing confusion, especially in the Second Circuit".

Thousands of yearly descriptive trademark registrants all over the country would appear to have been placed in jeopardy by this decision of the CAFC in view of their current reliance on the statutory exclusive and continuous five year use to establish "distinctiveness", and not on the proving of strict "secondary meaning", let alone by a "scientific survey".

Should, moreover, one rule of law any longer be permitted to apply to the granting of protection for descriptive trademarks in litigation between an opposer and trademark registrant, and another rule apply in litigation between the same parties in trademark infringement and unfair competition litigation?

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[7]. Pattishall, *Secondary Meaning in Trade Identity Cases; Some Questions and Suggested Answers,* 45 Trademark Rep. 1261, 1264-65 (1955)

[8]. Duke Law Journal, *Trade Name Protection: Relaxation of the 'Secondary Meaning' Requirement and Its Implications.* Vol. 1962, p. 307, p. 318, 1962.

It is believed that the present case provides the Supreme Court with an ideal opportunity to clarify and standardize the law of distinctiveness and secondary meaning in the light of this disarray of serious conflicting concepts all over the country.

The present case, with no factual disputes, affords a timely and deserving medium.

The urgency for such resolution is highlighted, moreover, by the fact that the States have now adopted the same Sec. 2f test of distinctiveness in their intrastate trademark laws. *(See footnote 4).*

Acceptance of this case will not only serve to provide long overdue clarity and uniformity to the law, but also to restore to your petitioner its hard-earned reputation residing in the world-wide established goodwill of its trademark, The Journal of Law and Technology.

CONCLUSION

The petition for a writ of certiorari should be granted.

Respectfully submitted.

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APPENDIX

Note: This opinion has not been prepared for publication in a printed volume because it does not add significantly to the body of law and is not of widespread legal interest. It is a public record. It is not citable as precedent. The decision will appear in tables published periodically.

United States Court of Appeals for the Federal Circuit

No. 89-1484

FRANKLIN PIERCE LAW CENTER,

Appellant,

v.

GEORGETOWN UNIVERSITY,

Appellee.

DECIDED: January 25, 1990

Before MARKEY, *Chief Judge,* BENNETT, *Senior Circuit Judge,* NIES, *Circuit Judge.*

PER CURIAM.

DECISION

This appeal by Franklin Pierce Law Center, a New Hampshire corporation, is from a unanimous decision of the United States Patent and Trademark Office Trademark Trial and Appeal Board (board), which sustained an opposition brought by Georgetown University (Georgetown) to Franklin Pierce's proposed registration of the title "The Journal of Law and Technology," the current subtitle of its journal, IDEA. We *affirm* the board's holding.

OPINION

The board held no secondary meaning was established here. To have held that the descriptive words have a distinctiveness for the applicant's product would have required that there be strong proof of a secondary meaning. The applicant's evidence on this was that the words had been used as a subtitle for IDEA since 1976 and that much money had been spent on the journal since that date. Further, correspondence and invoices used the words sought to be registered and statements from 10 people attest to the fact that they are unaware of other journals using the name "The Journal of Law and Technology." The board could not find that this was sufficient proof of secondary meaning in this case. Its holding was that the words were only descriptive terminology explaining what type of publication IDEA was and that length of use did not prove secondary meaning here. As to expenditures, the proof fell short of showing promotion of the words in the title or that the words have lost their descriptive significance and have acquired any secondary meaning thereby. Evidence of promotional activity was sparse. References by the applicant and others in correspondence were held insufficient to establish secondary meaning for the words in light of their highly descriptive nature. Letters by 10 subscribers solicited by the applicant with an eye toward this proceeding were held not to establish a scientifically accurate survey.

Hearing:
December 7, 1988

T. Henderson
Paper No. 23

U. S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Georgetown University
v.
Franklin Pierce Law Center, Incorporated

Opposition No. 76,021 to application Serial No. 586,218.
filed March 5, 1986.

Williams & Connolly for Georgetown University.

Rines and Rines and Nelson H. Shapiro and Ronald E. Shapiro for Franklin Pierce Law Center, Incorporated.

Before Rooney, Cissel and Quinn, Members.

Opinion by Cissel, Member:

Franklin Pierce Law Center, Inc., a New Hampshire corporation, applied to register "THE JOURNAL OF LAW AND TECHNOLOGY" on the Principal Register for "periodicals, namely journals whose contents deal with the interrelationship among science, innovation and legal systems."[1] The application is under the provisions of Section 2(f) of the Lanham Act. Applicant's claim of distinctiveness was accepted by the Examining Attorney based upon the affidavit of applicant's President, Robert Rines, who stated that as of July 1986, the words had been used exclusively and continuously for almost ten years by applicant as a trademark. No other support for the claim under Section 2(f) was either offered or requested.

[1] S.N. 586,218, filed March 5, 1986.

Timely Notice of Opposition was filed by Georgetown University, a District of Columbia corporation. As grounds for the opposition opposer asserts that the mark of applicant is merely descriptive, that it is an "apt and common term" to describe applicant's goods and that opposer itself uses the same words to describe a publication of its own. Opposer asserts that the words sought to be registered are generic, but that even if they are held to be only merely descriptive of applicant's goods, applicant has failed to establish that they have acquired secondary meaning and indicate applicant as the source of the goods. Applicant's answer is basically a denial.

The record before us includes the testimony and associated exhibits of Robert Rines, applicant's President; Ellen Dixon-Law, editor-in-chief of the Harvard Journal of Law and Technology; and Howard Jacobsen, former managing editor of the Journal of Law and Technology published by Georgetown University. Additionally, made of record by opposer's Notice of Reliance are copies of pages from various volumes of applicant's journal and covers and pages from periodical indices.

Based on this record we find that the term "JOURNAL OF LAW AND TECHNOLOGY" is an apt descriptive name for applicant's publication, and that as such, it is unregistrable as a trademark for these goods. Moreover, even if it had not been shown to be a generic term for these goods, applicant has failed to establish that it functions to identify applicant's publication and distinguish it from other similar publications.

The record shows that in 1973 applicant acquired the PTC Research Foundation from George Washington University, including the right to publish a legal periodical called "IDEA" and subtitled the "Patent Trademark and Copyright Journal of Research and Education". When applicant began publication, applicant modified the subtitle to "The PTC Journal of Research and Education." Then, in 1976, applicant began use of the present terminology, "The Journal of Law and Technology" along with "IDEA." The journal is referred to by applicant variously as "IDEA" or "IDEA THE JOUKNAL OF

LAW AND TECHNOLOGY," or as "THE JOURNAL OF LAW AND TECHNOLOGY."

In the spring of 1986, Opposer, Georgetown University, published a journal with the title "The Journal of Law and Technology". Harvard University has established a publication called "The Harvard Journal of Law and Technology", but although this publication has been organized and promoted, as of January 1988 the first issue had yet to be published.

There is no dispute as to the descriptiveness of the term sought to be registered. By making application under the provisions of Section 2(f) of the Act, applicant in effect concedes that the words are unregistrable under Section 2(e)(1) absent a showing of distinctiveness. Floss Aid Corp. v. John O. Butler Co., 205 USPQ 274 (TTAB 1979). At issue is the genericness of the term, and in the absence of proof that the term is generic, whether applicant has proved distinctiveness. A generic term can never be registered, even if there is evidence that it is associated with a single source. Miller Brewing Co. v. G. Heileman Brewing Co., 195 USPQ 281 (7th Cir. 1977), cert. denied, 434 U.S. 1025, 195 USPQ 592, (1978).

The case of In re Marvin Ginn Corp. v. Int'l Assn. of Fire Chiefs, 228 USPQ 528, 532 (Fed. Cir. 1986) sets forth a two-step inquiry for determining the genericness of a magazine title: "First, what is the class of publications or magazines at issue? Second, is the title understood by the relevant public to refer primarily to that class of magazines?" Both elements of this test are satisfied by the term sought to be registered in the case at hand.

The testimony of all three witnesses makes it quite clear that "Journal of Law and Technology" is simply an appropriate, apt descriptive name for a journal type of periodical which has as its subject the relationship between law and technology. Although applicant uses the words "science, innovation, and legal systems" in the application, the subject of the journal is described by applicant's president as "law and technology." (Rines' first deposition, p. 17: ". . . I thought this was a name that we ought to adopt as giving in the image, at the Franklin

Pierce Law School, of the pioneer law school concerned with the interfaces between law and technology.") The witnesses on behalf of opposer as well as the Harvard Law School are equally clear that they selected the words "Journal of Law and Technology" to use in combination with their school names because the words name the kind of publication they produce, or, in the case of Harvard, intend to produce.

Whether or not Harvard has actually produced a publication using these words in the title is not determinative of the case at hand. The testimony relates to the perceived meaning of these words. Georgetown has actually used them on publications generically. Although Harvard has used them in a generic sense when funds and articles to be published have been solicited, the initial issue bearing the words "Journal of Law and Technology" has not been produced. The words "Journal of Law and Technology" are no more or less generic after actual use on this kind of publication than they are prior to such use.

In a case analogous to this one, CES Publishing Corp. v. St. Regis Publications, Inc., 531 F.2d 11, 188 USPQ 612 (2d Cir. 1975), the court held "Consumer Electronics Monthly" to be generic for that type of publication. The court reasoned that it was hard to think of a name which more accurately names a class of magazines than to simply take the name of the trade which is the subject of the magazine and add to it the term "monthly". Similarly, it is difficult to describe more accurately a journal which has as its subject the interface between law and technology than by adding the words "Law and Technology" to the word "Journal." In Conde Nast Publications, Inc. v. Redbook Publishing Co., 217 USPQ 356 (TTAB 1983), the Board held "The Magazine For Young Women" to be a generic designation for such a publication, even though it had been extensively used as the subtitle for applicant's magazine. The Board noted, p. 361, that if proprietary rights were recognized in the generic designation, other such publications "would be hampered in their free use of these highly descriptive words."

In the situation now before us, Georgetown, Harvard, other institutions, or for that matter, anyone else who wants to

publish a journal on the subject of law and technology should be free to identify it using the ordinary terminology which would be understood by everyone interested in this emerging field to accurately name the kind or type of publication. Granting registration of the words "Journal of Law and Technology" to applicant or to anyone else would inhibit use by others of these generic words and therefore is not appropriate.

No amount or quality of evidence of distinctiveness can lead to registration of the common name of a thing. Miller Brewing, *supra;* Conde Nast, *supra.* If, however, the Board's holding that the term sought to be registered is a generic name for applicant's goods were to be reversed on appeal, our finding that applicant's evidence of secondary meaning is inadequate to prove distinctiveness should be noted.

The evidence applicant contends shows that "Journal of Law and Technology" has become distinctive consists of the following: (1) use of the words as either part of the title or as the subtitle on covers of applicant's journal since 1976; (2) expenditure of $600,000 by applicant on the journal since 1976; (3) invoices and correspondence showing applicant as well as others referring to applicant's journal using the words sought to be registered; and (4) written statements from ten people to the effect that they know that applicant publishes its journal and that they are unaware of other journals using the name "Journal of Law and Technology."

As to the first point, merely using descriptive terminology, even widely using it over an extensive period, does not necessarily result in such terminology acquiring secondary meaning as an indicator of source. In this case, the evidence shows that the words sought to be registered have generally been used in a descriptive sense immediately following the primary title of the journal, "IDEA." Each cover bears the heading, "IDEA" in large block letters across almost the entire width of the booklet, with "The Journal of Law and Technology" appearing directly beneath it in letters less than a fifth the size of the letters which form the word "IDEA." This evidence does not support the proposition that the words sought to be registered are perceived

as anything other than descriptive terminology explaining what type of publication "IDEA" is.

The expenditures in producing and promoting the journal hardly support the claim of distinctiveness for the words sought to be registered. There is no evidence of any extensive promotional activities, much less that the specific wording of even the complete title, "IDEA THE JOURNAL OF LAW AND TECHNOLOGY," has been widely promoted. This falls far short of proof that the final six words of the title have lost their descriptive significance and have acquired secondary meaning.

With regard to the third group of evidentiary materials submitted to show distinctiveness, the references by applicant and others to applicant's journal using only the words sought to be registered do not establish that the descriptive significance of the words has been lost. These materials show the words used in a shortened version of the title of the journal. For applicant to use them on invoices or for subscribers to use them in correspondence regarding the journal is not inconsistent with the retention of their descriptive significance. Indeed, calling the publication either "IDEA" or "THE JOURNAL OF LAW AND TECHNOLOGY" is less lengthy and less awkward than using the full title asserted by applicant, "IDEA THE JOURNAL OF LAW AND TECHNOLOGY", although there are examples of such use in the record. Evidence that a publisher or his customers correspond concerning the "LAW REVIEW" produced by the publisher would not establish that "LAW REVIEW" had become distinctive of the publication being so identified. Likewise, evidence that customers as well as the applicant in the case before us use the words, "THE JOURNAL OF LAW AND TECHNOLOGY" apart from "IDEA" to refer to applicant's journal does not establish secondary meaning for the words, especially in light of the highly descriptive nature of the words and their use by others to describe, rather than to identify, similar existing or planned publications.

The letters from subscribers similarly fail to establish secondary meaning for the words. These letters were admittedly solicited by applicant with an eye towards this proceeding. That these ten selected subscribers to the journal are familiar with its

full title, "IDEA THE JOURNAL OF LAW AND TECHNOLOGY", and are unaware of anyone else using the last six words of it does not prove that the descriptive significance of the words has been supplanted in the minds of a substantial portion of potential purchasers. This is not a scientifically accurate survey. Especially in light of the small number of people who offer their opinions in this way and the contrasting evidence that others have in fact used the same words descriptively in regard to their own publications, the letters from applicant's subscribers do not persuade us that distinctiveness has been attained by these words.

Applicant argues that other words are available to describe journals such as the one it produces, and that opposer has not met its burden of proof in that it failed to make a *prima facie* showing that the words that applicant seeks to register have not acquired distinctiveness.

The mere fact that other terms could also be used to name applicant's product does not prove that the name used by applicant is not generic. "To be held generic or a common descriptive name, it is not necessary that the designation be the only apt or common name of the goods . . ." (Conde Nast, *supra* at p. 360).

As to applicant's argument that opposer failed to meet its burden, the court in Yamaha International Corp. v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ 2d 1001 (Fed. Cir. 1988) made it abundantly clear that an applicant has the ultimate burden of establishing the registrability of its mark. Because this matter is before us for a final decision on the merits based on a full record after a complete trial, rather than in the context of an interlocutory motion prior to development of a complete record, the sole issue for our determination is which party should prevail based on the entire record. The burdens of creating or rebutting *prima facie* showings are not relevant at this stage of this opposition proceeding.

In summary, these words applicant seeks to register are the common name of the goods on which they are used. As such, they are unregistrable under Section 2(e)(1) of the Act.

Moreover, even if these words could somehow be determined to be only merely descriptive of the goods, rather than a generic name for them, applicant has failed to prove that they have acquired distinctiveness and serve to distinguish applicant's journals from those of others. Accordingly, registration under Section 2(f) of the Act is inappropriate. The opposition is sustained.

L. E. Rooney
R. F. Cissel
T. J. Quinn
Members, Trademark
Trial and Appeal Board

GJS
Paper No. 24

U. S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Georgetown University
v.
Franklin Pierce Law Center, Incorporated

Opposition No. 76,021

Correction

Williams & Connolly for Georgetown University.
Rines and Rines for Franklin Pierce Law Center, Incorporated.

Before Rooney, Cissel and Quinn, Members.
Opinion by Cissel, Member:

The Board's decision of March 2, 1989 is amended as follows:

On page 1, line 12 is amended by deleting "Nelson H. Shapiro and Ronald E. Shapiro" as counsel for applicant.

Emma S. Brown
Administrator
Trademark Trial and
Appeal Board

ORDER

Before MARKEY, Chief Judge, NIES, Circuit Judge, and BENNETT, Senior Circuit Judge.

A petition for rehearing having been filed in this case,

UPON CONSIDERATION THEREOF, it is

ORDERED that the petition for rehearing be, and the same hereby is, denied.

The suggestion for rehearing in banc is under consideration.

The mandate will issue on March 2, 1990.

FOR THE COURT,

Dated: February 23, 1990

Francis X. Gindhart
Clerk

cc: NANCY RICHARDS-STOWER
DANIELA WINKLER

FRANKLIN PIERCE V GEORGETOWN UNIV, 89-1484 (PTO - 76,021)

Note: This order has not been prepared for publication in a reporter.

15 U.S.C. § 1063. Opposition to registration

Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the required fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Commissioner for good cause when requested prior to the expiration of an extension. The Commissioner shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Commissioner.

(As amended Jan. 2, 1975, Pub.L. 93-596, § 1, 88 Stat. 1949; Jan. 2, 1975, Pub.L. 93-600, § 1, 88 Stat. 1955; Aug. 27, 1982, Pub.L. 97-247, § 9(a), 96 Stat. 320.)

15 U.S.C. § 1063, as amended, effective Nov. 16, 1989

(a) Any person who believes that he would be damaged by the registration of a mark upon the principal register may, upon payment of the prescribed fee, file an opposition in the Patent and Trademark Office, stating the grounds therefor, within thirty days after the publication under subsection (a) of section 1062 of this title of the mark sought to be registered. Upon written request prior to the expiration of the thirty-day period, the time for filing opposition shall be extended for an additional thirty days, and further extensions of time for filing opposition may be granted by the Commissioner for good cause when requested prior to the expiration of an extension. The Commissioner shall notify the applicant of each extension of the time for filing opposition. An opposition may be amended under such conditions as may be prescribed by the Commissioner.

"(b) Unless registration is successfully opposed—

"(1) a mark entitled to registration on the principal register based on an application filed under section 1051(a) or pursuant to section 1126 of this title shall be registered in the Patent and Trademark Office, a certificate of registration shall be issued, and notice of the registration shall be published in the Official Gazette of the Patent and Trademark Office; or

"(2) a notice of allowance shall be issued to the applicant if the applicant applied for registration under section 1051(b) of this title."

15 U.S.C. § 1052(f)

Except as expressly excluded in paragraphs (a)-(d) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as applied to the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years next preceding the date of the filing of the application for its registration.

July 5, 1946, c. 540, Title I, § 2, 60 Stat. 428; Oct. 9, 1962, Pub.L. 87-772, § 2, 76 Stat. 769; Jan. 2, 1975, Pub.L. 93-596 § 1, 88 Stat. 1949.

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Except as expressly excluded in paragraphs (a)-(d) of this section, nothing in this chapter shall prevent the registration of a mark used by the applicant which has become distinctive of the applicant's goods in commerce. The Commissioner may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.

Fla. Stat. Ann. Sec. 495.021(e) (West 1988)

The Department of State may accept as evidence that the mark has become distinctive, as applied to the applicant's goods or services, proof of continuous use thereof as a mark by the applicant in this state or elsewhere for 5 years next preceding the date of the filing of the application for registration.

Tex. Bus. & Com. Code Ann. Sec. 16.02(b) (Vernon 1987)

The secretary of state may accept as evidence that a mark has become distinctive as applied to the applicant's goods or services proof of substantially exclusive and continuous use of the mark by the applicant in this state for the five years next preceding the date on which the applicant filed his application for registration.

Cal. Bus. & Prof. Code Sec. 14220(e) (West 1987)

The Secretary of State may accept as evidence that the mark has become distinctive, as applied to the applicant's goods or services, proof of continuous use thereof as a mark by the applicant in this state or elsewhere for the five years next preceding the date of the filing of the application for registration.

N.Y. Gen. Bus. Law, Sec. 361(e) (McKinney 1984)

The secretary of state may accept as evidence that the mark has become distinctive, as applied to the applicant's goods or services, proof of continuous use thereof as a mark by the applicant in this state or elsewhere for the five years next preceding the date of the filing of the application for registration.

Ill. Ann. Stat. ch. 140, para. 9(2(e)) (Smith-Hurd 1986)

The Secretary of State may accept as evidence that the mark has become distinctive, as applied to the applicant's goods or services, proof of continuous use thereof as a mark by the applicant in this State or elsewhere for the 5 years next preceding the date of the filing of the application for registration.